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No. 73-1480

In the
Supreme Court of the United States
October Term, 1973

DONALD M. UMPHREY and
DOUGLAS J. MARSDEN,
Petitioners,

vs

McGRAW-EDISON COMPANY,
Respondent.

PETITIONERS' REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Samuel B. Smith
60 East 42nd Street
New York, New York 10017

Ralph E. Church, Jr.
Gregory B. Beggs
77 West Washington Street
Chicago, Illinois 60602
Attorneys for Petitioners

The Scheffer Press, Inc.—(312) 263-6350

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It appears from respondent's brief and the petition that both sides agree upon one matter: The Court of Appeals decided the patent infringement issue as it did because it felt that the District Court had not come to grips with the issue of alleged obviousness in the manner prescribed in *Graham* v *John Deere Co.*, 383 U.S. 1, 17 (1966). Beyond that, respondent (hereinafter "defendant") fails to address **any** of the questions presented in the petition. Apparently defendant finds comfort only in the ultimate decision of the Court of Appeals in defendant's favor.

Defendant's argument ignores the Court of Appeals' holdings that Umphrey's patent covers a novel concept (B21), and that his concept is incorporated in defendant's circuit breakers (*ibid.*), but attempts to justify that Court's holding that the patent is not infringed.

Petitioners do not disagree with defendant's premise that patent claim interpretation is a matter of law.* But an appellate court's interpretation should not ignore facts found at the trial level which are not clearly erroneous. The Court of Appeals in the instant case could not find any fault with the trial court's findings of fact.

Neither do petitioners dispute an appellate court's right **in a proper case** to follow the "documentary rule" espoused by defendant (R.Br. 4). However, reference to the trial testimony (e.g., B41-55) readily demonstrates that this is not such a case. Defendant's further *in terrorem* comments (R.Br. 5), that this Court need not "re-hash the entire documentary record developed below" and other allegations of a "bulky documentary record" (R.Br. 6), are less than persuasive since the trial lasted just three and one-half days.

Defendant's attempt (R.Br. 5) to characterize the issue in this case as "whether each of patent claims 1, 2, 6 and 7 are infringed by the manufacture, use and sale of the McGraw AHJ and HF circuit breakers, when such claims are interpreted under the tests of invention required by the *Graham* analysis," is misleading and legally wrong. Infringement is determined by the language of the claims, interpreted if necessary by reference to the patent specification and the history of the patent application in the

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* See Respondent's Brief in Opposition to Petition for Certiorari, hereinafter "R.Br.," at p. 3.

Patent Office.* The *Graham* case, on the other hand, has to do with the issue of patent validity under 35 U.S.C. §103, and involves determining the scope and content of the prior art, differences between patent claims and the prior art, the level of skill of persons skilled in the art, and such secondary considerations as commercial success.

The alleged "differences," quoted out of context by defendant (R.Br. 5) from the Court of Appeals' judgment order (B22) compare the Umphrey patent claims with the accused circuit breakers, **not with the prior art,** and thus have nothing to do with *Graham* validity determinations. Even these "differences" were recognized by the Court of Appeals as "arguably existing" (*ibid.*), and are, in fact, technically unsound (Petition, pp. 20-22).

Defendant also urges that it is entitled to the benefit of a "file wrapper estoppel" (R.Br. 6-7), notwithstanding the fact that neither court below found any basis for such an estoppel. Defendant cites no authority for the proposition that a file wrapper estoppel can be applied when the patent claims were never changed in the Patent Office. It is undisputed that the Umphrey claims in suit were never changed.

The importance of the opportunity of the trial court to hear the live testimony of a witness is stressed in the petition. Defendant's current enthusiasm for "estoppel" re-emphasizes the impropriety of the action of the Court of Appeals in ignoring the trial court's express conclusion that (B13):

> "There is nothing in the conduct of plaintiffs, or either of them, as revealed by the evidence in this case,

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*See cases cited in the Petition, pp. 18-19.

constituting . . . (c) any basis for an estoppel against asserting the patent in suit as covering the defendant's accused devices."

Defendant also attacks the petition as untimely (R.Br. 1-2). The petition was docketed in this Court on April 4, 1974, well within the ninety (90) day period following the Court of Appeals' denial on January 14, 1974 of plaintiffs' timely application for rehearing (B28). Defendant's contention is without merit. See *United States* v. *Healy*, 376 U.S. 75, 77-80 (1964), and Stern and Gressman, *Supreme Court Practice*, Fourth Ed. 1969, § 6.3, and cases there cited.

CONCLUSION

In no way does defendant's brief detract from the importance of the Questions Presented in the petition.

Respectfully submitted,

SAMUEL B. SMITH
60 East 42nd Street
New York, New York 10017

RALPH E. CHURCH, JR.
GREGORY B. BEGGS
77 West Washington Street
Chicago, Illinois 60602
Attorneys for Petitioners